



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/941,869

08/30/2001

Pascal Arnaud

212527US0

7528

22850

7590

06/10/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

06/10/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/941,869	<b>Applicant(s)</b> ARNAUD, PASCAL	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on March 12, 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-27, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-27, 44-51, 58, 62-78, 81-95, 101, 102, 105, 106 and 109-112 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In view of the pre-appeal request filed on April 5, 2010, PROSECUTION IS  
HEREBY REOPENED.

All of the rejections made under 35 U.S.C. § 103 (a) as indicated in the final  
Office action dated November 12, 2009 are withdrawn. The Nojima (EP 548694)  
reference, cited in the previous rejections, is no longer applied in view of the applicant's  
remarks. JP 63119412 abstract has been withdrawn in view of further consideration.

New rejections are set forth below.

Claims 53-57, 60, 61 have been withdrawn from consideration in view of the  
response to restriction requirement with traverse made on January 24, 2003. As for the  
species elections, applicant has elected poly(hydroxy-12stearic) acid as a specific  
dispersant and octyldodecyl neopentanoate as a specific non-volatile hydrocarbon.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly  
claiming the subject matter which the applicant regards as his invention.

**Claims 20 and 73 are rejected under 35 U.S.C. 112, second paragraph, as  
being indefinite for failing to particularly point out and distinctly claim the subject  
matter which applicant regards as the invention.**

The Markush language of Claims 20 and 73 is confusing. Claims 20 and 73  
depend on claims 11 and 62, respectively, and limit the non-volatile hydrocarbon-based  
compound of the base claims to a compound selected from "the group consisting of  
diisostearyl malate, polyol monoesters **and** polyesters **and** poly(12-hydroxystearic

Art Unit: 1611

acids), and mixtures thereof". (emphasis mine). Due to the repeated recitation of "and" between the components, it is not clear whether polyol monoesters, polyesters and poly(12-hydroxystearic acids) should be considered as separate species or one single species of the said non-volatile hydrocarbon-based compound.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 5-10, 24-27, 31-35, 37-42, 44-51, 58, 62, 65-69, 77, 78, 81-83, 85-95, 101-102, 105-107, 109-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul (US 5738841).**

The independent claims, claims 62 and 101, are directed to a transfer-resistant composition comprising (a) at least one non-volatile hydrocarbon-based oil with a molecular mass ranging from 230 to 420 g/Mol; (b) a silicone component consisting of one or more enlisted non-volatile silicone compound(s) in the claim; (c) from about 0.1-30 % by weight of the composition of an inert particulate phase; and (d) from 0 to about 5 % by weight of the total weight of the composition of a volatile oil, wherein the composition does not contain a silicone compound which is alkoxyated.

Mellul teaches a homogenous cosmetic composition comprising at least one silicone-containing compound in combination with a hydrocarbon compound of high molecular mass. See col. 1, lines 46 - 53. The reference discloses a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone (non alkoxyated non-volatile silicone oil), 5%

Art Unit: 1611

alkyldimethicone (non-alkoxylated non-volatile silicone), and 12 % pigments. See examples 5 and 6; instant claims 5-10, 62(a), (b), 63-69, 91-95, 101(a), (b), 102, 107. The examples do not contain any volatile silicone oil, and See instant claims 62(d), 101 (d), 91, 111 and 112. Mellul does not require any alkoxylated silicone compounds, meeting the negative limitation of claim 101. Mellul also teaches that silicone compounds used in cosmetics “make it possible to improve the staying power of the make-up on account of their hydrophobic nature.” See col. 1, lines 10 – 16. Therefore, the transfer-free property of the Mellul invention is suggested. The compositions are said to have good cosmetic properties and does not impart a dry sensation when applied to the skin. See col. 1, lines 63 – 65; example 5.

The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 5-10, 32-35, 82. The reference teaches octyldodecyl neopentanoate is “an excellent agent for compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it”. See col. 2, lines 11 – 21. The reference further teaches the ester has dispersant properties with respect to powders, and makes it possible to make a homogeneous dispersion. See col. 2, lines 21 – 24. The reference also teaches using at least one silicone-containing compound such as polymethylsiloxanes, alkyldimethicone, polyphenylmethylsiloxane, more specifically, phenyldimethicone and phenyltrimethicone; and silicones modified with aliphatic and/or aromatic groups, which optionally contain fluorine, or with functional groups such as

Art Unit: 1611

hydroxyl, thiol and/or amine groups. See col. 2, lines 47- col. 3, line 5; see Example 3. See instant claims 105, 107, 109, and 110. Mellul further teaches the compositions can be formulated into various products including compacted powder (foundation, blusher or eyeshadow) or anhydrous products (lipstick, mascara). See col. 4, lines 11-16; instant claims 50, 51, 93, and 94.

Regarding claims 41-45, 87-90, 101(c), Mellul teaches the compositions can contain a pulverulent phase comprising pigments and/or fillers (inert particulates). Possible pigments and fillers suitable for the make up compositions are taught, with some, for example, titanium dioxide coated mica and pearlescent, are named as either pigments or fillers. See col. 3, lines 30-45. The disclosed lipstick formulations of Examples 5 and 6 contain 11.9 % and 12 % of pigments, respectively, and do not specifically indicate the amount of fillers. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, based on the disclosure that a pulverulent phase can contain pigments and/or fillers, and lipstick formulations comprising specific amounts of pigments, the amount of fillers does not appear to be critical. It is viewed obvious for a skilled artisan to have discovered optimal amount of fillers of similar compositions within the disclosed range of pigments by routine experimentations.

Mellul's disclosure of cyclomethicones (volatile oils) as an alternate choice to the non-volatile oils of instant claim 101 (b) would have obviously suggested to a person of ordinary skill in the art that cyclomethicones or volatile silicone oils are not a required component in making the Mellul compositions. See col. 2, line 47 – col. 3, line 6. Furthermore the reference discloses working examples 5 and 6 that are free of volatile silicone oils. Mellul also indicates in col. 1, lines 22 – 27 that volatility of isoparaffins, a hydrocarbon oil, is not "always appreciated" in cosmetic art. Therefore, excluding cyclomethicones or volatile silicone oils in lipstick formulation according to the teachings of Mellul as applicant has done in claims 101 (d), 91, and 111 and 112 would have been an obvious matter to a skilled artisan.

**Claims 2-4 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul as applied to claims 5-10, 24-27, 31-35, 37-42, 44-51, 58, 62, 65-69, 77, 78, 81-83, 85-95, 101-102, 105-107, 109-112 above, and further in view of Jacks et al. (US 5690918).**

Mellul is relied upon as discussed above. Although Mellul further teaches the composition may also comprise additional hydrocarbon compounds such as esters and octyldodecanol (MW 299), et., the reference does not specifically disclose non-volatile hydrocarbon oil having the MW limitation of instant claims 2-4 and the dispersant of the instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

Jacks teaches low viscosity ester oils such as isononyl isononanoate, octyl palmitate, dioctylmaleate, octyldodecanol have been used in lip care products to provide "desirable feel, spreadability, gloss and other desirable characteristics". See col. 5,

Art Unit: 1611

lines 49 -65; See Example 2; instant claims 2-4. Isononyl isononanoate (non volatile hydrocarbon oil, MW 284.48 g/mole).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Mellul by adding to the composition additional hydrocarbon oils such as isononyl isononanoate and/or octyldodecanol as motivated by Jacks because the references are directed to lipstick formulations and Jacks teaches that these low viscosity hydrocarbon oils are conventionally blended with other oils to provide "desirable feel, spreadability, gloss and other desirable characteristics" to the lip care product. Since Mellul teaches esters and octyldodecanol may be combined with its compositions, the skilled artisan would have had a reasonable expectation of successfully producing an improved lipstick compositions having enhanced cosmetic properties including spreadability and gloss.

**Claims 11-23, 36, 63, 70-76, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul as applied to claims 5-10, 24-27, 31-35, 37-42, 44-51, 58, 62, 65-69, 77, 78, 81-83, 85-95, 101-102, 105-107, 109-112 as above, and further in view of Rokitowski (US 5750127 A1) and Arquette (US 5968530A).**

Mellul is relied upon as discussed above. The reference does not teach the dispersants of the instant claims.

Rokitowski teaches polyhydroxystearic acid is a well known dispersant in cosmetic art which is used to disperse the pigments or colorants throughout the product. See col. 3, lines 23-31. The reference teaches using 0.5-2 wt % of polyhydroxystearic acid.



Arquette discloses lipstick formulations each comprising polyhydroxystearic acid in the amount of 0.5 wt %. See Examples IV and VIII.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Mellul by adding to the prior art composition polyhydroxystearic acid as motivated by Rokitowski and Arquette as Rokitowski teaches the dispersant is conventionally used in cosmetics to disperse the pigments or colorants throughout the product. Since Rokitowski teaches of a suitable weight range for the dispersant and Arquette teaches lipstick formulations containing polyhydroxystearic acid, discovering an optimal weight range of the dispersant in the cosmetics according to Mellul would only take ordinary skill in the art. Since the Mellul compositions are pigmented cosmetics, the skilled artisan would have had a reasonable expectation of successfully producing an improved cosmetic products having enhanced dispersion of the pigments and colorants in the composition.

### ***Response to Arguments***

Applicant's arguments filed on March 31, 2010 have been considered but are moot in view of the new ground(s) of rejection in part and unpersuasive in part.

In the request for pre-appeal review, applicant asserts that the previous rejection made in view of Mellul and Nojima (EP 548694) teaches away from the applicant's composition since the Nojima invention is directed to using polyoxyalkylene modified organopolysiloxane in formulating cosmetic compositions. The argument is viewed persuasive, and the Nojima reference has been withdrawn. Examiner views that Mellul

Art Unit: 1611

alone would have sufficiently rendered the same claims obvious, therefore the rejection has been modified as indicated above.

Applicant asserts Jacks utilizes 49-50 wt % of volatile oil in forming a transfer-resistant film, whereas the present invention uses only a limited or no volatile oil (0-5 wt %). However, Jacks in fact teaches the volatile solvent can be present in an amount of as low as 1 wt %, which reads on the instant claims. See col. 4, lines 32-39.

Furthermore, Mellul already describes cosmetic compositions comprising applicant's silicone oil(s) and hydrocarbon oil, which imparts staying power, good cosmetic and sensory properties. Jacks was cited to show that the hydrocarbon oil of the instant claims had been conventionally used in lipstick art. The reference indicates that the non-volatile hydrocarbon oils of instant claims such as isononyl isononanoate had been ***conventionally used in lip care products*** to impart the desirable cosmetic properties (feel, spreadability, gloss, etc.). A person of ordinary skill in the art would have obviously understood that these beneficial characteristics of the low viscosity non-volatile esters would have been obtainable when incorporated in Mellul formulation

### ***Conclusion***

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flick teaches diisostearyl malate, a dispersant of the instant claims, is a good binder for pigmented cosmetic products and an "excellent additive for imparting gloss and sheen in makeup". See Cosmetics Additives, p. 672. See also Soyama et al. (US 5672339) Examples 1-3, containing the dispersant at 3 wt %.

Art Unit: 1611

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/  
Primary Examiner, Art Unit 1611

/Sharmila Gollamudi Landau/  
Supervisory Patent Examiner, Art Unit 1611